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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,144	04/20/2001	Masayuki Tsuchiya	06501-076001	9796

7590 09/27/2002
Fish & Richardson
225 Franklin Street
Boston, MA 02110-2804

EXAMINER

SWOPE, SHERIDAN

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 09/27/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/830,144	TSUCHIYA ET AL.	
	Examiner	Art Unit	
	Sheridan L. Swope	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-40 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-11 and 27, drawn to methods for screening compounds that inhibit signaling through inflammatory cytokines wherein, said methods test the ability of said compounds to inhibit TAK1 and TAB1 binding.

Group II, claim(s) 12 and 14-17, drawn to methods screening compounds that inhibit signaling through inflammatory cytokines wherein, said methods test the ability of said compounds to inhibit phosphorylation by TAK1.

Group III, claim 13, drawn to methods for screening compounds that inhibit signaling through inflammatory cytokines wherein, said methods test the ability of said compounds to inhibit phosphorylation by TAK1 in the presence of TAB1.

Group IV, claim(s) 18-20 and 24-26, drawn to methods for screening compounds that inhibit signaling through inflammatory cytokines wherein, said methods test the ability of said compounds to inhibit signaling via TAK1 in intact cells.

Group V, claim(s) 21-23, drawn to methods for screening compounds that inhibit signaling through inflammatory cytokines wherein, said methods test the ability of said compounds, in the presence of TAB1, to inhibit signaling via TAK1 in intact cells.

Group VI, claim(s) 28-40, drawn to compounds that inhibit signal transduction through TAK1.

The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: Products of Group VI were known in the art (Sukurai et al, 1999). Sukurai et al teach that the inflammatory cytokine tumor necrosis factor activates NF-kB by signaling through TAK1 (Fig 8). The ability of TAK1 to activate NF-kB is blocked by expression of a dominant negative form of IkappaB kinase (Fig 3). In addition, Sukurai et al teach that a dominant negative TAK1 also inhibits tumor necrosis factor-induced activation of NF-kB. Thus, dominant negative forms of IkappaB kinase and TAK1 are compounds that inhibit signal transduction through TAK1. Therefore Groups I-VI share no special technical feature as defined by PCT Rule 13.2. Furthermore, the methods of Groups I-V do not share a special technical feature with each other or the products of Group VI.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1652


Note: Articles of non-patent literature supplied in the IDS are missing every other page due to incorrect double paged to single paged Xeroxing. It is requested that new complete copies of the non-patent literature be supplied.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 703-305-1696. The examiner can normally be reached on M-F; 8:30-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached on 703-308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Sheridan L. Swope, Ph.D.


REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP 1800
1600